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APR 27 2004

OFFICE OF PETITIONS

Applicant: Ruben et al.
Appl. No.: 09/882,171
Filing Date: June 18, 2001
Title: 186 HUMAN SECRETED PROTEINS
Attorney Docket No.: PZ002P2C1
Pub. No.: US 2003/0175858 A1
Pub. Date: September 18, 2003

This is in response to the request for correction of patent application publication under 37 CFR 1.221(b), which was filed on November 13, 2003.

The request is **DISMISSED**.

The instant request is that the application be republished because the patent application publication contains two errors on the front page of the patent application publication wherein the filing date for Provisional Application No. 60/057,761 is incorrectly listed as September 5, 1997, instead of "August 22, 1997, Provisional Application No. "60/061,660 filed on October 9, 1997" is listed instead of "60/061,060 filed on October 2, 1997" and in claim 1 clause (h) the SEQ ID NO: designation should be changed from "y" to "Y" and in clause (i) the phrase "only a residues or of only t residues" should be changed to "only A residues or of only T residues".

37 CFR 1.221(b) is applicable "only when the Office makes a material mistake which is apparent from Office records . . . Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.¹

The typographical errors in claim 1 clause (h) wherein the SEQ ID NO: designation should be changed from "y" to "Y" and in clause (i) wherein the phrase "only a residues or of only t residues" should be changed to "only A residues or of only T residues" are Office errors, but they are minor typographical errors, which are clearly understandable. The mistakes are clearly understandable as the symbols are used elsewhere in the specification and claims correctly and

¹Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239 Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

phrased are not read in a vacuum. The mistake are minor typographical errors which are clearly understandable from reading the specification and sentence in which the symbols are used, as terms and phrases are not read in a vacuum. The mistake does not affect the public's ability to appreciate the technical disclosure of the patent application publication, or determine the scope of the patent application publication or determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.

With respect to the Provisional Applications, the Office correctly published the application in accordance with 37 CFR 1.215(a). According to the Office records, the filing date for Provisional Application No. 60/057,761 is September 5, 1997 and the Office uses the filing date in the Office records, not the filing date provided by applicant. The first Filing Receipt provided by the Office, which listed Provisional Application No. 60/061,660 was correct, as item 95 in the benefit claim in the first sentence of the application (and the Declaration filed with the application) listed Provisional Application No. "60/061,660 filed on October 9, 1997", not "60/061,060 filed on October 2, 1997" as argued by applicant now and earlier in the request for a corrected filing receipt. The Office's electronic records have been corrected, as Provisional Application No. "60/061,060" has been changed back to "60/061,660," as that Application No. was listed in the benefit claim. (Corrected Filing Receipt is enclosed.) It is noted that applicant has not amended the application to correct the error in the benefit claim in the first line of the application.

It is noted that applicant is attempting to claim the benefit of an earlier filed provisional application. Since the benefit claim was not filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application, the benefit of the earlier filed application is considered to have been waived. To make a late benefit claim to the earlier filed application, applicant must submit a petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of the earlier filed provisional application. The petition must include 1) the surcharge (\$1330.00) set forth in 37 CFR 1.14(t) and 2) a statement that the entire delay between the date the claim was due under paragraph (a)(5) of this section and the date the claim was filed was unintentional. The petition must also include a proper reference (amendment) to the prior applications in order for the petition to be granted.²

The applicant is advised that a "request for republication of an application previously published" may be filed under 37 CFR 1.221(a). Such a request for republication "must include a copy of the application in compliance with the Office's electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i)." If the request for republication does not comply with the electronic filing system requirements, the republication will not take place and the publication fee set forth in § 1.18(d) will be refunded. The processing fee will be retained.

Any request for republication under 37 CFR 1.221(a), should be submitted via the EFS system and questions or request for reconsideration of this decision, should be addressed as follows:

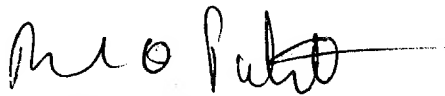
²See Claiming the Benefit of a Prior-Filed Application under 35 U.S.C. §§ 119(e), 120, 121, and 365(c), 1268 Off. Gaz. Pat. Office Notices 89 (March 18, 2003).

By mail to: Mail Stop PGPUB
Commissioner for Patents
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By facsimile: 703-305-8568

The application will be examined in due course.

Inquiries relating to this matter may be directed to Mark Polutta at (703) 308-8122 (voice) or (703) 746-3465 (facsimile).



Mark O. Polutta
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Enclosure: Corrected Filing Receipt